



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

H. B. Fuller Company
Patent Department
1200 Willow Lake Boulevard
Box 64683
St. Paul, MN 55164-0683

In re Application of	:	
Greg S. Mueller et al.	:	DECISION ON PETITION
Application No. 09/193,889	:	TO WITHDRAW THE
Filed: November 18, 1998	:	HOLDING OF ABANDONMENT
For: MOISTURE ACTIVATED REINFORCEMENT		
STRING AND TEAR OPENING TAPES FOR		
CORRUGATED AND CARTONSTOCK		
CONTAINERS		

This is in response to applicant's renewed petition to withdraw the holding of abandonment filed in the United States Patent and Trademark Office (USPTO), on July 26, 2002. There is no fee for this petition.

The petition is **DISMISSED**.

A review of the file record reveals that a non-final Office action was mailed to the applicant on March 27, 2000. Since no response to the March 27, 2000 Office communication was timely filed, the application was held abandoned, and a notice to that effect mailed November 7, 2001. Although the Notice of Abandonment indicated that the application became abandoned for failure to timely respond to the Office action of November 16, 2000, this was in error. The application was already abandoned as of November 16, 2000, and thus no redating of the Office action absent a petition to restore the application to pending status could be made. The Office action mailed November 16, 2000 was thus nothing more than a courtesy copy for applicant's records.

A further review of the file reveals that the Office action of March 27, 2000 was mailed to the correct address of record; 1200 Willow Lake Blvd., St Paul, MN 55110-5101, which is the address given in the original declaration filed with the application. A change of address was filed in this case on July 6, 2000, changing the correspondence address to: 1200 Willow Lake Blvd., Box 64683, St. Paul, MN 55164-0683. Because this address change was not made until after the mailing of the Office action of March 27, 2000, the action was properly mailed to the correspondence address of record at that time. Because there was no error on the part of the Office in mailing the March 27, 2000 Office action, there was no grounds to redate and remail the Office action upon receipt of the change in correspondence address.

Applicant's petition indicates that "in September 1996, H.B. Fuller changed it's mailing address from the street address to a post office box address...". Applicant also states that "by November 16th the Post Office had agreed to deliver mail that was addressed to the H.B. Fuller street address". The MPEP 601.03 states,

"Where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP code)..."

"The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record."

Because the applicant apparently filed the application with a correspondence address that had changed as of September 1996 and that the post office was not delivering to until November of 2000, there was no apparent Patent and Trademark Office error in the mailing of the Office communication and the holding of abandonment will not be withdrawn.

Given that the applicant failed to change the correspondence address it is not surprising that the applicant failed to receive the above-noted Office action. While MPEP 711.03(c) does give an applicant the ability to petition to show that a communication from the Patent Office was not received, this is predicated on the fact that applicant was able to receive mail at the correspondence address. MPEP 711.03(c) also requires an applicant to show that "due care was taken to adhere to the requirement for prompt notification in each concerned application for the change of address". Clearly applicant had a different mailing address since at least September of 1996. Since applicant was apparently not able to receive mail at the address of record, and the Office action of March 27, 2000 was correctly mailed to the address of record, the procedure outlined in 1156 OG 53 is not available to the applicant and the alleged showing of non-receipt of the Office action is not persuasive to withdraw the holding of abandonment in this application.

Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(l); and **(3)** an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(m); and **(3)** a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is \$110. The fee for a petition under the unintentional standard is \$1,280. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

Further correspondence with respect to a petition to revive should be addressed as follows:

By mail: Deputy Commissioner of Patent Examination Policy
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By Hand: Crystal Plaza 4, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Please contact me directly for inquiries specific to this decision.



Steven Meyers, Special Program Examiner
Patent Technology Center 3600
(703) 308-3868
Facsimile No.: (703) 605-0586

SM: 9/22/02